REMARKS/ARGUMENTS

The Examiner is thanked for the Office Action mailed July 14, 2009. The status of the application is as follows:

- Claims 34-53 are pending, and claims 34, 43, 45, 50 and 53 have been amended;

- Claims 34-44, 50 and 53 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter;

- Claim 50 is rejected under 35 U.S.C. 112, second paragraph; and

- Claims 34-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer et al. (US 5,740,267) in view of Fenster et al. (US 5,454,371) and in further view of Wiedenhoefer (US 5,832,422).

The rejections are discussed below.

Preliminary Matters: Claims 34-53

The subject Office Action does not establish a *prima facie* case of obviousness because it does not identify which features of the prior art correspond to the claimed elements and limitations. To meet the burden of establishing a *prima facie* case of obviousness, the Office must explain how the rejected claims are obvious by pointing out where the specific limitations of the claims are found in the prior art. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. (MPEP §706). The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (37 C.F.R. §1.104(c)(2)). **Here, the pertinence of the references is not apparent. Thus, applicant requests that the Examiner identify each feature or element in the cited reference which is deemed to correspond to the claimed elements and limitations, and, if possible, the location in the cited reference where the relevant feature or element is discussed in a non-final Office Action.**

Amendments to Claims 1, 45 and 53

Claims 1, 45 and 53 have been amended to further emphasize claimed aspects. The amendments do not address issues of patentability, and no new subject matter has been added.

Claim Informalities

Claim 43 has been amended to fix a typographical error.

The Rejection under 35 U.S.C. 101

Claims 34-44, 50 and 53 stand rejected under 35 U.S.C. 101. In particular, the Office asserts that the claims are directed to non-statutory subject matter. Claims 34-44 and 53 have been amended to overcome this rejection and thus the rejection of these claims should be withdrawn. Claim 50 has been amended to correct a typographical error, rendering the rejection thereto moot.

The Rejection of Claim 50 under 35 U.S.C. 112, Second Paragraph

Claim 50 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 50 has been amended as noted above, rendering the rejection thereto moot.

The Rejection of Claims 34-53 under 35 U.S.C. 103(a)

Claims 34-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer et al. in view of Fenster et al. and further in view of Wiedenhoefer. This rejection should be withdrawn because the combination of Echerer et al., Fenster et al., and Wiedenhoefer does not establish a *prima facie* case of obviousness with respect to the subject claims.

> The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). MPEP §2143.

Independent **claim 34** is directed to a method including, *inter alia*, receiving a first user input that indicates a selected location on the medical image and that indicates a selected set of

sequential graphic modes. The combination of Echerer et al., Fenster et al. and Wiedenhoefer does not teach or suggest at least this claim aspect.

The Office asserts that Echerer et al. teaches the above claim aspect (Office Action, p. 14, third sentence). However, the Office has failed to identify a location in the cited reference where this feature is taught and the pertinence of Echerer et al. is not clear. It appears that the Office is asserting that the above claim aspect is taught in Echerer et al. at col. 10, lines 1-10, because in the subject Office Action, p. 14, first sentence, preceding the above assertion, the Office states that Echerer et al. teaches "soft controls" such as buttons, slides, and adjustment tools using software and operated with a mouse. The Office concludes that Echerer et al. teaches using a pointer device to place points and identify the measurement graphic, and thus enabling the generation of the measurement graphics without requiring a user to define a type of graphic being generated.

Applicant respectfully disagrees that the cited reference teaches the above claim aspect in the cited section and with the Office's conclusion. The cited section of Echerer et al. teaches that a variety of "soft controls" (buttons, slides, and adjustment tools created using software and operated with a mouse) are displayed on one portion of a monitor, while the image is displayed on another portion of the monitor. This section of Echerer et al. fails to teach or suggest using a pointer device to place points and identify the measurement graphic, and thus enabling the generation of the measurement graphics without requiring a user to define a type of graphic being generated as the Office has concluded. Echerer et al. further teaches that a user must first define a type of graphic being generated and then subsequently identify one or more locations on the image for measurement.

For example, Echerer et al. teaches at col. 13, lines 26-50, that when performing a Manual Analysis of an image, such as for example, measuring the distance between two points ("Landmarks"), a user presses the "Distance" button on a Manual Analysis Menu. The user then positions the mouse cursor on the first desired point and presses the left mouse button, and then repositions the mouse cursor on another point and again presses the left mouse button (col. 13, lines 35-39). Thus, Echerer et al. teaches that the type of graphic is defined by pressing a measurement button on a menu and then subsequently using a pointer device to identify points in the image for the measurement.

In another example, Echerer et al. teaches at col. 15, lines 16-19, that when the user decides to measure an angle in an image, the user presses a "Measure Angle" button on the Manual Analysis menu. The user then clicks a second time via the left mouse cursor on two existing lines that have been drawn previously (col. 15, lines 17-19). Echerer et al. further teaches at col. 16, line 16 to col. 18, line 32, that when performing an Automatic Analysis of an image for a particular type of physical condition, a numeric sequence of points in the image must be collected, which are used in predefined calculations to diagnose the physical condition.

None of the above sections of Echerer et al. teach or suggest receiving a first user input that indicates a selected location on the medical image and that indicates a selected set of sequential graphic modes as required by claim 34.

The Office also asserts that Fenster et al. teaches receiving a first user input that indicates a selected location/point on the medical image and a selected set of sequential graphic modes (Office Action, p. 18, second sentence). However, the Office has failed to identify a location in the cited reference where this feature is taught and the pertinence of Fenster et al. is not clear. Notwithstanding the foregoing, applicant respectfully disagrees that the cited reference teaches this claim aspect.

Fenster et al. teaches at col. 23, lines 25-34, that when a Measure Icon is selected from a control window positioned beside the main display window (Fig. 26), a measure display window appears on the screen (Fig. 27). The user may use the graphical input device to measure distances and areas of the three-dimensional image within the most recently moved plane (col. 23, lines 26-29). If the user wishes to measure a distance, the user simply needs to use the graphical device to indicate the two end points over which the distance is to be measured (col. 23, lines 30-32). If an area is to be measured, the user must identify at least three points (col. 23, lines 32-34). Thus, Fenster et al. teaches that the type of graphic is defined by pressing a button on a measurement menu then subsequently using a pointer device to identify points in the image for the measurement.

None of the above sections of Fenster et al. teach or suggest receiving a user input that indicates a selected location/point on the medical image and that indicates a selected set of sequential graphic modes as required by claim 34.

In view of the above, it is readily apparent that Echerer et al. and Fenster et al., individually or in combination, do not make or suggest claim 34.

Independent **claims 45 and 53** recite claim aspects similar to those recited in claim 34. As such, the above discussion with respect to claim 34 applies *mutatis mutandis* to claims 45 and 53, and this rejection should be withdrawn.

Claim 35 depends from claim 34 and requires, *inter alia*, that the first user input corresponds to a mouse-click in combination with an identifier of the selected set. The Office asserts that Echerer et al. (col. 10, lines 1-10), Fenster et al. (col. 19, and col. 23) and Wiedenhoefer (col. 18) disclose this claim aspect. Applicant respectfully disagrees.

Instead, Echerer et al. teaches at col. 10, lines 1-10, that a variety of "soft controls" (buttons, slides, and adjustment tools created using software and operated with a mouse) are displayed on one portion of a monitor, while the image is displayed on another portion of the monitor. Fenster et al. teaches in col. 23, lines 25-32, that when the Measure Icon is selected, a measure display window appears on the screen. The user then uses a graphical input device (mouse) to indicate the two end points over which the distance is to be measured (col. 23, lines 30-32). Wiedenhoefer teaches at col. 17, line 65 – col. 18, line 15, that a user presses the "2" button on a numeric keypad to select the ANGLE mode when a measuring device is displaying the main menu. The sides of the angle are input into the device by moving the centerline of the LCD screen along the sides of the angle by the user pressing respective left and right control buttons on the keypad (col. 18, lines 1-10).

None of these sections of the cited references teach a mouse-click in combination with an identifier of the selected set as required by claim 35.

Accordingly, this rejection should be withdrawn.

Claims 36 and 46 respectively depend from independent claims 34 and 45 and require, *inter alia*, that the first user input corresponds to a mouse-click in combination with an identifier of the selected set. The Office asserts that Echerer et al. (col. 10, lines 1-10, col. 13, lines 12-49, and col. 15, lines 9-11), Fenster (col. 19, and col. 23) and Wiedenhoefer (col. 18) disclose the above emphasized claim aspect. Applicant respectfully disagrees.

Instead, Echerer et al. teaches at col. 10, lines 1-10, that a variety of "soft controls" (buttons, slides, and adjustment tools created using software and operated with a mouse) are

displayed on one portion of a monitor, while the image is displayed on another portion of the monitor. Echerer et al. also teaches at col. 13, lines 12-49, that when performing a Manual Analysis of an image, such as for example, measuring the distance between two points ("Landmarks"), a user presses the "Distance" button on a Manual Analysis Menu. The user then positions the mouse cursor on the first desired point and presses the left mouse button, and then repositions the mouse cursor on another point and again presses the left mouse button (col. 13, lines 35-39). Echerer et al. also teaches at col. 15, lines 9-11, that the colors and width of a line to be drawn are obtained from the System Startup Menu and retained in CPU memory from startup. These items may be changed at any time by the user (col. 15, lines 10-11). None of these sections of Echerer et al. teach or suggest the above claim aspect.

The cited sections of Fenster et al. and Wiedenhoefer are discussed above with respect to the rejection of claim 35. None of these sections of Fenster et al. and Wiedenhoefer teach or suggest the above claim aspect.

In view of the above, this rejection should be withdrawn.

Claim 38 depends from claim 34 and requires, *inter alia*, that the terminating input corresponds to a selection of a previously selected location on the medical image. The Office asserts that Echerer et al. (col. 10, lines 1-10, col. 13, lines 12-49, and col. 15, lines 9-11), Fenster (col. 19, and col. 23) and Wiedenhoefer (col. 18) disclose the above claim aspect. Applicant respectfully disagrees. These sections of Echerer et al., Fenster et al. and Wiedenhoefer are discussed above with respect to the rejection of claims 35, 36 and 46. None of these sections of Echerer et al., Fenster et al. and Wiedenhoefer teach or suggest the above claim aspect. Accordingly, this rejection should be withdrawn.

Claims 39 and 48 respectively depend from independent claims 34 and 45 and require, *inter alia*, that when the next sequential mode corresponds to a last sequential mode in the set of sequential graphic modes, subsequent next sequential modes are defined as repetitions of the last sequential mode. The Office asserts that Echerer et al. (col. 10, lines 1-10, col. 13, lines 12-49, and col. 15, lines 9-11), Fenster (col. 19, and col. 23) and Wiedenhoefer (col. 18) disclose the above claim aspect. Applicant respectfully disagrees. These sections of Echerer et al., Fenster et al. and Wiedenhoefer are discussed above with respect to the rejection of claims 35, 36 and 46.

None of these sections of Echerer et al., Fenster et al. and Wiedenhoefer teach or suggest the above claim aspect. Accordingly, this rejection should be withdrawn.

Claims 41 and 50 respectively depend from independent claims 34 and 45 and require, *inter alia*, that the set of measuring modes includes, in sequential order: point mode, line mode, angle mode, curve mode, and region mode. The Office asserts that Echerer et al. (col. 10, lines 1-10, col. 13, lines 12-49, and col. 15, lines 9-11), Fenster (col. 19, and col. 23) and Wiedenhoefer (col. 18) disclose the above claim aspect. Applicant respectfully disagrees. These sections of Echerer et al., Fenster et al. and Wiedenhoefer are discussed above with respect to the rejection of claims 35, 36 and 46. None of these sections of Echerer et al., Fenster et al. and Wiedenhoefer teach or suggest the above claim aspect. Accordingly, this rejection should be withdrawn.

Claim 42 depends from independent claim 34 and requires, *inter alia*, that the set of drawing modes includes, in sequential order: freehand mode and poly-line mode. The Office asserts that Echerer et al. (col. 10, lines 1-10, col. 13, lines 12-49, and col. 15, lines 9-11), Fenster (col. 19, and col. 23) and Wiedenhoefer (col. 18) disclose the above claim aspect. Applicant respectfully disagrees. These sections of Echerer et al., Fenster et al. and Wiedenhoefer are discussed above with respect to the rejection of claims 35, 36 and 46. None of these sections of Echerer et al., Fenster et al. and Wiedenhoefer teach or suggest the above claim aspect. Accordingly, this rejection should be withdrawn.

Claims 37, 40, 43-44, 47, 49 and 51-52 respectively depend from independent claims 34 and 45, and are allowable at least by virtue of their dependencies.

Conclusion

In view of the foregoing, it is submitted that the claims distinguish patentably and non-obviously over the prior art of record. An early indication of allowability is earnestly solicited.

Respectfully submitted,

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